

R. Kent
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#14/Reply
Brief



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the reissue application of:

Don A. Perry and H. Earl Wright

Title: Touch Enhancing Pad

Serial No. 07/337,253

Filed April 13, 1989

Art Unit 335

Examiner: R. Shay

91-2492

REPLY BRIEF

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Commissioner of Patents
and Trademarks
Washington, D.C. 20231

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The Applicants submit this Reply Brief pursuant to 37 C.F.R. §1.193 (b) to address the new point of argument raised in the Examiner's Answer concerning the changing status of the In re Dillon case.

In the Appeal Brief, the Applicants cited In re Wright, 848 F.2d 1216 (Fed. Cir. 1988), and In re Dillon, 892 F.2d 1554 (Fed. Cir. 1989) ("Dillon I"), which endorsed the rationale of In re Wright. In the Examiner's Answer, the Examiner pointed out that the Court of Appeals for the Federal Circuit had accepted a suggestion for a rehearing in banc of the Dillon case filed by the Commissioner of Patents and Trademarks. After rehearing, the Court of Appeals withdrew the opinion in Dillon I and, on November 9, 1990, superseded it with a new opinion ("Dillon II") which is reported at 919 F.2d 688. A petition for certiorari was filed on February 7, 1991. See BNA's Patent, Trademark &

Copyright Journal, Vol. 41, p. 351. The Applicants are unaware of whether the Supreme Court has made a decision to grant or deny the petition.

In any event, the Applicants acknowledge that the legal issues addressed in Dillon I and II pertaining to the establishment of a prima facie case of obviousness are unsettled. However, the Examiner has not argued that the prima facie presumption is applicable in the present case. Furthermore, even if the presumption is applicable, the law remains clear that the presumption can be rebutted by showing, for example, that the claimed invention possesses "unexpectedly improved properties or properties that the prior art does not have" Dillon II at 692-693.

In the present case, nothing in Paschal or Beck suggests that the massage pads disclosed therein could possess touch enhancing properties. Affidavits by Professor Ichniowski confirm that the prior art devices do not, in fact, possess the physical properties necessary for touch enhancement and which are recited in Claim 12. Accordingly, regardless of the outcome of Dillon II and regardless of whether Paschal and Beck create a prima facie case of obviousness, the surprising touch enhancing properties of the apparatus recited in Claim 12 confirm its patentability.

The Applicants again request the Board of Patent Appeals and Interferences to reverse the Final Rejection of the Examiner and to allow Claims 1 to 12.

Respectfully submitted,

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CERTIFICATE OF MAILING

PHILIP L. BATEMAN certifies that three copies of this Reply Brief are deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C., 20231, on April 11, 1991.

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